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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,527	07/10/2003	Craig Fellenstein	AUS920030364US1	3550
50170	7590	08/13/2007	EXAMINER	
IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. P.O. BOX 832745 RICHARDSON, TX 75083			JEAN GILLES, JUDE	
		ART UNIT	PAPER NUMBER	
		2143		
		MAIL DATE	DELIVERY MODE	
		08/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,527	FELLENSTEIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 May 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 08/31/2006.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This office action is responsive to communication filed on 05/22/2007.

### ***Information Disclosure Statement***

1. The references listed on the Information Disclosure Statement submitted on 07/10/2003 and 08/31/2006, have been considered by the examiner (see attached PTO-1449A).

### ***Response to Amendment/Arguments***

2. In the claims, 1-33 remain pending in the application with claims 1, 2, 6-11, 16-20, and 25-29 amended. Claims 1-33 represent a method and apparatus for an "E-MAIL ROUTE TRACE FUNCTIONALITY."

Applicant's arguments with respect to claims 1, 7 and 25 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the existing ground of rejection as explained here below. Applicants' amendments to the independent claims are not properly made and as to perhaps place them in condition for allowance.

In response to Applicant's arguments, 37 CFR § 1.11(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must show the amendments avoid such references or objections."

Applicant's Request for Reconsideration filed on 05/22/2007 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention:

A: *the email to at least one non-original recipient. Applicants respectfully submit that Klug does not teach or suggest that any tracing of the path that an email, sent by an original recipient, takes through a network to the at least one non-original recipient is ever sent to the original sender. That is, Klug merely teaches sending, to an original sender, the tracing of the path that an email takes to an original recipient. Klug does not teach or suggest a feature where the tracing notifications are received at a computing device of the original sender from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient.*

B: *Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination.*

C: *Independent claims 7, 16, and 25 recite similar subject matter to that in independent claim 1. That is independent claims 7, 16, and 25 recite "transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients in response to an e-mail message being forwarded by an original recipient to at least one non-original recipient." (emphasis added).*

As to point A, it is the position of the Examiner that forwarding and email from one original recipient to other recipient as indicated in the rejection of claim 1 below [see Klug; column 28; lines 58-67; column 30, lines 33-47]. In addition, klug discloses tracing the routing of such emails , thus permitting the original sender to know information such as which servers or possible sites that emails have been forward to or from. Furthermore, techniques to retrace the network path of the email/communication is also provided. [see Klug; see *Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29.*]

*As to point B, see rejection of claim 1 below for reason to combine and motivation.*

*Point C as stated by the applicants states the same subject matter as claim 1. see point A above*

Examiner notes that no new matter has been added and that the new claims are supported by the application as filed. However, applicant has failed in presenting claims and drawings that delineate the contours of this invention as compared to the cited prior art. Applicant has failed to clearly point out patentable novelty in view of the state of the art disclosed by the references cited that would overcome the 103(a) rejections applied against the claims, the rejection is therefore sustained.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessa et al (hereinafter Lessa) U.S. Publication No. 2002/0040387 A1 in view of Klug U.S. Patent No. 7,085,745 B2.

**Regarding claim 1:** Lessa discloses the invention substantially as claimed. Lessa teaches a method for providing electronic mail (e-mail) services (fig. 1), said method comprising:

receiving from an original sender a request for tracing notifications, for an e-mail message (see abstract; also see par. 0022);

in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications [par.0003; par. 0006];

receiving at a computing device of the original sender said tracing notifications [par.0003; par. 0006] from one or more non-original recipients in response ; and

providing limits for said tracing notifications [par. 0022; *note that the limits for the tracing notification are expressed in terms of...among other things, the date, and time the email message was opened...]*; however, Lessa does not disclose in details the step

"~~wherein said tracing notifications operate when said e-mail message [[is]] being forwarded by an original recipient~~ to at least one non-original recipient".

In the same field of endeavor, Klug discloses "*the certified mail features of the franking systems described herein may include a tracing function. That is, when a franked e-mail/communication 105 is certified for delivery, its path through the network 120 from the sending e-mail/communication server 210 to the receiving mail/communication server 225 may be logged....a first class or higher category e-mail/communication 105 may be forwarded to a plurality of additional recipients and/or to the first recipient if the first attempt failed and bounced. Such forwards may occur, for example, without payment of additional franks by a forwarding recipient or sender. Alternately, such forwards may occur to N additional recipients, wherein N may be defined by the original sender, the recipient or otherwise..."* [see Klug; column 28; lines 58-67; column 30, lines 33-47]. Further, Klug teaches the tracing notifications are received from one or more non-original recipients in response [see *Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29*]. In an attempt to facilitate identifying, controlling, disseminating, and/or receiving communication in general and e-mail communications in particular so that systems and processes can become more reliable and secure.

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Klug's teachings of using tracing notifications operate when said e-mail message is forwarded to at least one non-original recipient with the teachings of Lessa," ...to provide a system and/or

process enabling a sender of an e-mail/communication (or another form of electronic communications) to categorize, prioritize, or otherwise handle such a e-mail/communication ... " as stated by Klug in lines 16-20 of column 4. By this rationale, **claim 1 is rejected.**

**Regarding claim 2:** the combination Lessa-Klug discloses the method of claim 1, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said providing limits further comprises one or more limiting actions selected from [[the]] a group consisting of:

limiting the time during which said tracing notifications operate [see Lessa; par. 0022; *note that knowing the date and time to open and access an email message implies the function of controlling the timing of viewing such email notification*],

limiting the number of retransmissions for which said tracing notifications operate [par 0022],

limiting said tracing notifications operation, based on a domain policy [see Lessa; par. 0022],

limiting the content of said tracing notifications [see Lessa; par. 0022], and discontinuing said tracing notifications, in response to a signal from said original sender [see Lessa; par. 0022; *note that the address gateway is used to send a message back to the original sender*].

**Regarding claim 3:** the combination Lessa-Klug discloses the method of claim 1, further comprising: providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e-mail message [see Lessa; par. 0005].

**Regarding claim 4:** the combination Lessa-Klug discloses the method of claim 3, further comprising: storing and updating said information [par. 0016, and 0027].

**Regarding claim 5:** the combination Lessa-Klug discloses the method of claim 1, further comprising: transmitting said tracing notifications to said original sender [see Lessa; par. 0022]., from said at least one non-original recipient [see Klug; column 30, lines 33-47].

**Regarding claim 6:** the combination Lessa-Klug discloses the method of claim 5, wherein said transmitting tracing notifications further comprises transmitting one or more tracing notifications selected from [[the]] a group consisting of:

notifications reporting that said message has been sent somewhere in some manner [see Lessa; par. 0003],

notifications reporting that the content of said message was provided to said at least one non-original recipient [see Klug; column 30, lines 30-47], and

notifications reporting deletion of said message [see Klug; column 9, lines 39-52].

**Regarding claim 7:** the combination Lessa-Klug discloses a method for providing e-mail services (see Lessa; fig. 1), said method comprising:

in response to a request from an original sender, transmitting tracing notifications to a computing device of said original sender [see Lessa; par. 0003, and 0006] ] from one or more non-original recipients in response [see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29]; and

providing limits for said tracing notifications [see Lessa; par. 0022];  
wherein said tracing notifications operate when an e-mail message [[is]] being forwarded to by an original recipient at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 8:** the combination Lessa-Klug discloses the method of claim 7, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said providing limits further comprises: limiting the time during which said tracing notifications operate [see Lessa; par. 0022].

**Regarding claim 9:** the combination Lessa-Klug discloses the method of claim 7, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67,  
continue in lines 3-2 2 in column 29], wherein said providing limits further comprises:  
limiting the number of retransmissions for which said tracing notifications operate [see  
Lessa; par. 0022].

**Regarding claim 10:** the combination Lessa-Klug discloses the method of claim 7,  
further comprising:

providing limits for said tracing notifications, wherein said providing limits further  
comprises: responsive to a signal from said original sender, discontinuing said tracing  
notifications [see Lessa; par. 0022].

**Regarding claim 11:** the combination Lessa-Klug discloses the method of claim 7,  
further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67,  
continue in lines 3-2 2 in column 29], wherein said providing limits further comprises:  
limiting said transmitting, based on a domain policy [see Lessa; par. 0010].

**Regarding claim 12:** the combination Lessa-Klug discloses the method of claim 7,  
wherein said transmitting tracing notifications further comprises: signaling that the  
content of said e-mail message has been provided to said at least one non-original  
recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 13:** the combination Lessa-Klug discloses the method of claim 7, wherein said transmitting tracing notifications further comprises: signaling that said e-mail message has been forwarded to said at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 14:** the combination Lessa-Klug discloses the method of claim 7, further comprising: providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e-mail message [see Lessa; par. 0005].

**Regarding claim 15:** the combination Lessa-Klug discloses the method of claim 14, further comprising: storing and updating said information [see Lessa; par. 0016, and 0027].

**Regarding claim 16:** the combination Lessa-Klug discloses a system for providing e-mail services (see Lessa; fig. 1), said system comprising:

means for receiving from an original sender a request for tracing notifications, for an e-mail message (see Lessa; see abstract; also see par. 0022);  
means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications [see Lessa; par.0003; par. 0006]; and

means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender [see Lessa; par.0003; par. 0006] from one or more non-original recipients in response [see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29] ; -and

~~means for providing limits for said tracing notifications [see Lessa; par.0003; par. 0006];~~

~~wherein said tracing notifications operate when said e-mail message is forwarded by an original recipient to at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].~~

**Regarding claim 17:** the combination Lessa-Klug discloses the system of claim 16, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means for limiting the time during which said tracing notifications operate [see Lessa; par. 0022].

**Regarding claim 18:** the combination Lessa-Klug discloses the system of claim 16, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means for limiting the number of retransmissions for which said tracing

notifications operate [see Lessa; par. 0022].

**Regarding claim 19:** the combination Lessa-Klug discloses the system of claim 16, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means responsive to a signal from said original sender, for discontinuing said tracing notifications [see Lessa; par. 0022].

**Regarding claim 20:** the combination Lessa-Klug discloses the system of claim 16, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means for limiting said transmitting, based on a domain policy [see Lessa; par. 0010].

**Regarding claim 21:** the combination Lessa-Klug discloses the system of claim 16, wherein said means for transmitting tracing notifications further comprises: means for signaling that the content of said e-mail message has been provided to at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 22:** the combination Lessa-Klug discloses the system of claim 16,

wherein said means for transmitting tracing notifications further comprises: means for signaling that said e-mail message has been forwarded to said at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 23:** the combination Lessa-Klug discloses the system of claim 16, further comprising: means for providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e-mail message [see Lessa; par. 0005].

**Regarding claim 24:** the combination Lessa-Klug discloses the system of claim 23, further comprising: means for storing and updating said information [see Lessa; par. 0016, and 0027].

**Regarding claim 25:** the combination Lessa-Klug discloses a computer-readable medium having computer-executable instructions for providing e-mail services (see Lessa; fig. 1), said computer-readable medium comprising:

means for receiving from an original sender a request for tracing notifications, for an e-mail message (see Lessa; see abstract; also see par. 0022);  
means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications [see Lessa; par. 0003; par. 0006]; and

means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender [see Lessa; par.0003; par. 0006] from one or more non-original recipients in response [see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29]; -; and

~~means for providing limits for said tracing notifications [see Lessa; par.0003; par. 0006];~~

~~wherein said tracing notifications operate when said e-mail message [[is]] being forwarded to at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].~~

**Regarding claim 26:** the combination Lessa-Klug discloses the computerusable medium of claim 25, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means for limiting the time during which said tracing notifications operate [see Lessa; par. 0022].

**Regarding claim 27:** the combination Lessa-Klug discloses the computerusable medium of claim 25, further comprising:

providing limits for said tracing notifications[see Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29], wherein said means for providing limits further comprises: means for limiting the number of retransmissions for which said tracing notifications

operate [see Lessa; par. 0022].

**Regarding claim 28:** the combination Lessa-Klug discloses the computerusable medium of claim 25, further comprising:

providing limits for said tracing notifications[see *Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29*], wherein said means for providing limits further comprises: means responsive to a signal from said original sender, for discontinuing said tracing notifications [see Lessa; par. 0022].

**Regarding claim 29:** the combination Lessa-Klug discloses the computerusable medium of claim 25, further comprising:

providing limits for said tracing notifications[see *Klug, column 8, lines 58-67, continue in lines 3-2 2 in column 29*], wherein said means for providing limits further comprises: means for limiting said transmitting, based on a domain policy [see Lessa; par. 0010].

**Regarding claim 30:** the combination Lessa-Klug discloses the computerusable medium of claim 25, wherein said means for transmitting tracing notifications further comprises: means for signaling that the content of said e-mail message has been provided to at least one non-original recipient [see *Klug; column 28, lines 58-67; column 30, lines 30-47*].

**Regarding claim 31:** the combination Lessa-Klug discloses the computer-usable medium of claim 25, wherein said means for transmitting tracing notifications further comprises: means for signaling that said e-mail message has been forwarded to said at least one non-original recipient [see Klug; column 28, lines 58-67; column 30, lines 30-47].

**Regarding claim 32:** the combination Lessa-Klug discloses the computer-usable medium of claim 25, further comprising: means for providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e-mail message [see Lessa; par. 0005].

**Regarding claim 33:** the combination Lessa-Klug discloses the computer-usable medium of claim 32, further comprising: means for storing and updating said information [see Lessa; par. 0016, and 0027].

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

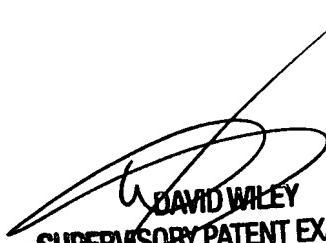
Jude Jean-Gilles

Patent Examiner

Art Unit 2143

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August 1, 2007

  
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